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09/864,017	05/23/2001	Veijo Vantinen	297-010337-US(PAR)	9980				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VEIJO VANTTINEN and HAITAO TANG

Appeal 2008-005153
Application 09/864,017
Technology Center 2400

Decided:¹ June 18, 2009

Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAY P. LUCAS
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 27-34. Claims 1-26 are indicated to be allowable by the Examiner. We have jurisdiction under 35 U.S.C. § 6(b).

Invention

Appellants' claimed invention is related to a mobile station and a packet data device being an integral part of a mobile station or being attachable to a mobile station. (Spec. 6; Fig. 9).

Illustrative Claims

This appeal contains claims 27-34. Independent claims 27 and 33 illustrate the invention as follows:

27. A packet data device (950) being an integral part of a mobile station or being attachable to a mobile station, comprising

means (960) for receiving information about a location information request and about a sender of a location information request from a mobile station and

means (970) for exchanging with a network element connected to a cellular network information about a security association, which points to the network element from the sender of the location information request.

33. A mobile station (901), comprising

means for receiving a notification from a cellular network about the location information request,

means for responding to the cellular network with a notification response, and

means for notifying a packet data device, which is either an integral part of the mobile station or attached to the mobile station, about the location information request.

References

Jokiaho	US 5,889,770	Mar. 30, 1999
Havinis	US 6,671,377 B1	Dec. 30, 2003 (filed Mar. 18, 1999)
Barnes	US 6,711,147 B2	Mar. 23, 2004 (filed Jun. 15, 1999)

Rejections

Claims 33-34 are rejected under 35 U.S.C. § 102(e)² as being anticipated by Jokiaho.

Claims 27-32 is rejected under 35 U.S.C § 103(a) as being unpatentable over Havinis in view of Jokiaho, and further in view of Barnes.

² Jokiaho has the published date Mar. 30, 1999 which is one year early than the US filing date of the present application, May 23, 2001. Therefore, claims 33-34 should/may be rejected under 35 U.S.C. § 102(b) as being anticipated by Jokiaho.

II. ISSUE

The issue before us is whether claims 27-34 are sufficiently definite in claim scope so as to evaluate the patentability of the claims in view of the cited prior art. In particular, the issue turns on whether the claims themselves or Appellants' Specification discloses adequate structure, material, or acts that perform the functions recited in independent claims 33 and 27.

III. PRINCIPLES OF LAW

35 U.S.C. §112, sixth paragraph

Where means-plus-function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. The Federal Circuit has made clear that the USPTO is to interpret means-plus-function language according to 35 U.S.C. §112, sixth paragraph. *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). When a claim uses the term "means" to describe a limitation, a presumption inheres that the inventor used the term to invoke § 112, ¶ 6. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). "This presumption can be rebutted when the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety." *Id.* Once a court concludes that a claim limitation is a means-plus function

limitation, two steps of claim construction remain: 1) the court must first identify the function of the limitation; and 2) the court must then look to the Specification and identify the corresponding structure for that function. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003). "If there is no structure in the specification corresponding to the means-plus-function limitation in the claims, the claim will be found invalid as indefinite." *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007); see also *In re Donaldson*, 16 F.3d at 1195.

35 U.S.C. §112, second paragraph

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

35 U.S.C. §112, first paragraph

In *Greenberg*, the Court of Appeals for the Federal Circuit stated:

In *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 71 USPQ 175 (1946), the Supreme Court held invalid a claim that was drafted in means-plus-function fashion. Congress enacted paragraph six, originally paragraph three, to overrule that holding. In place of the *Halliburton* rule, Congress adopted a compromise solution, one

that had support in the pre-*Halliburton* case law: Congress permitted the use of purely functional language in claims, but it limited the breadth of such claim language by restricting its scope to the structure disclosed in the specification and equivalents thereof. *See Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1041-42, 25 USPQ2d 1451, 1453-54 (Fed. Cir. 1993); *In re Fuetterer*, 319 F.2d 259, 264 n.11, 138 USPQ 217, 222 n.11 (CCPA 1963). (Emphasis added.)

Greenberg v. Ethicon Endo-Surgery Inc., 91 F.3d 1580, 1582 (Fed. Cir. 1996).

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. *See United States v. Teletronics, Inc.*, 857 F.2d 778, 785, (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); *In re Stephens*, 529 F.2d 1343, 1345, (CCPA 1976).

IV. FINDINGS OF FACT

The following Findings of Fact (FF) are supported by a preponderance of the evidence.

1. Appellants used “means plus function” language in the claims 27 and 33 to define the claimed invention. (App. Br. 57 and 58, Claims Appendix).
2. Claims 27 and 33 do not recite any structure that would perform the claimed functions such as receiving information about a location information

request or exchanging with a network element, recited in claim 27 and receiving a notification from a cellular network, responding to the cellular network, or notifying a packet data device, recited in claim 33 (App. Br. 57 and 58, Claims Appendix).

3. The Summary of the Claimed Invention at page 4 of the Brief identifies Appellants' Specification at page 18 and Fig. 9. Appellants' Specification describes the claimed subject matter of claim 27, which has no structure, material or acts corresponding to the functions recited in the claim, as follows:

A packet data device 950 is either an integral part of a mobile station or it is a separate device which can be attached to a mobile station. In the latter case it may be, for example, a laptop computer or a personal organizer. The packet data device 950 has means (960) for receiving information about a location information request and about a sender of a location information request from the mobile station and means (970) for exchanging with a network element connected to a cellular network information about a security association, which points to the network element from the sender of the location information request.

(Spec. 18, Fig. 9).

4. The Summary of the Claimed Invention at page 4 of the Brief identifies Appellants' Specification at page 18. Appellants' Specification describes the claimed subject matter of claim 33, which has no structure, material or acts corresponding to the functions recited in the claim, as follows:

The mobile station 901 has means for receiving from a cellular network a notification about a location information request and means for responding to the cellular network with a notification response. It furthermore has means for notifying a device, which is attached to the mobile station, about the location information request.

The means for responding to the cellular network may expect the device to give a permission, and only thereafter send a positive response is sent to the cellular network. In other words, the means for responding to the cellular network are initiated by a permission sent by the device.

(Spec. 18, Fig. 9).

V. ANALYSIS

35 U.S.C §112, sixth paragraph

A presumption arises that Appellants used “means” in claims 27 and 33 to define their invention, thus, invoked 35 U.S.C § 112, sixth paragraph (FF1). The claims themselves do not recite any structure that would perform these claimed functions in their entirety (FF2). Hence, the presumption is not rebutted by any structure recited in the claims. As such, the presumption § 112, sixth paragraph applies, and we are required to interpret the claim limitations pursuant to Title 35, Section 112, sixth paragraph.

Furthermore, the rules of the Board require that the Appeal Brief contain:

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(l)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth

paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference character.

37 C.F.R. § 41.37(c)(1)(v).

Thus, we consult the Appellants' Summary of the Claimed Subject Matter in the Appeal Brief to assess whether the Specification describes structure, material, or acts corresponding to “means” recited in the claims for performing the functions recited in claims 27 and 33.

The Appellants describe the subject matter of claims 27 and 33 in the Appeal Brief as follows:

Claim 27 recites a packet data device (Fig. 9, Ref. No. 950) being an integral part of a mobile station or being attachable to a mobile station (P. 17, L. 1-4; P. 18, L. 4-5). The packet data device comprises means (Fig. 9, Ref. No. 960) for receiving information about a location information request and about a sender of a location information request from a mobile station (P. 18, L. 6-8). Means (Fig. 9, Ref. No. 970) for exchanging with a network element connected to a cellular network information about a security association, which points to the network element from the sender of the location information request (P. 18, L. 8-11).

Claim 33 recites a mobile station comprising means for receiving a notification from a cellular network about a location information request (p. 18, L. 27-28). Means for responding to the cellular network with a notification response (P. 18, L. 28-29). Means for notifying a packet data device, which is either

an integral part of the mobile station or attached to the mobile station, about the location information request (P. 18, L. 29-30).

(App. Br. 4)

The cited portions of the Appellants' Specification have substantially the same language as that recited in independent claims 27 and 33 respectively. We find no structure, material, or acts corresponding to "means" for performing the functions recited in claims 27 and 33 (FF3 and FF4). Therefore, Appellants have failed to disclose any sufficient structure for performing the functions cited in the means elements contained in claims 27 and 33 so as to render the claims definite. Hence, we are left to speculate what structures can be used for performing the functions recited in the claims.

While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obliged to do. Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Accordingly, we are constrained to reverse, *pro forma*, the Examiner's

rejections of claims 27-32 under 35 U.S.C. § 103 and claims 33-34 under 35 U.S.C. § 102. We hasten to add that this is a procedural reversal rather than one based upon the merits of and the section 103 rejection and the section 102 rejections.

VI. NEW GROUNDS OF REJECTION

We enter a new ground of rejection of claims 27-34 under 35 U.S.C. § 112, second paragraph, and a new ground of rejection of claims 27-34 under 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 112, second paragraph

As already noted, the means plus function language recited in claims 27 and 33 renders the claims indefinite since Appellants have identified no structure, acts or material disclosed in either claims themselves or the Specification to carry out the functions recited in the claims. The claimed elements, “means” are amenable to more than one plausible claim construction. For example, we could speculate that the “means” for notifying a “device” of claim 33 could be a multiplexer, an USB device, or a address bus device, etc. Appellants have provided no guidance as to what Appellants intend the claim language to cover with respect to the means plus function limitations.

Due to the ambiguity as to what is intended by the claimed “means” and the fact that those claimed elements are amenable to two or more

plausible claim constructions, we enter a new ground of rejection of claims 27-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Appellants consider to be the invention.

35 U.S.C. § 112, first paragraph (scope of enablement)

We enter a new ground of rejection of claims 27-34 under 35 U.S.C. § 112, first paragraph, because the claimed functions recited in claim 27 and 33 are purely functional recitations with no structural limitations.

The so-called ‘Halliburton rule’ proscribed ‘conveniently functional language at the exact point of novelty.’ *Halliburton*, 329 U.S. at 8. More generally, *Halliburton* proscribed purely functional claiming by prohibiting a patentee from using ‘broad functional claims’ to ‘obtain greater coverage by failing to describe his invention than by describing it as the statute commands.’ *Id.* at 12-13.... ‘purely functional claim language’ is now permissible but only under the conditions of 35 U.S.C. § 112, sixth paragraph, i.e., if its scope is limited to the corresponding structure, material, or act disclosed in the specification and equivalents thereof. In the absence of such limited construction, ...any claim that includes purely functional claim language, and which is not subject to the limited construction under 35 U.S.C. § 112, sixth paragraph, fails to meet the requirements of 35 U.S.C. § 112, first paragraph, according to reasoning in *Halliburton* and thus is unpatentable.”

Ex parte Miyazaki, No. 2007-003300, 25-26 (BPAI Nov. 19, 2008) (precedential).

In this case, as already noted, all the “means” limitations recited in the

claims have neither structural recitations in the claims themselves nor have corresponding structural descriptions in the Specification (FF2, FF3, and FF4). “[S]uch unlimited purely functional claiming may reasonably be construed to encompass any and all structures for performing the recited function, including those which are not what the applicant invented.” *Id.* at 27. Therefore, claims 27 and 33 are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure commensurate with the scope of the claims. Claims 28-32 depend from claim 27; and claim 34 depends from claim 33. As such, claims 28-32 and 34 are likewise unpatentable for the same reasons.

VII. CONCLUSION

For the aforementioned reasons, we conclude that the claims themselves or Appellants’ Specification do not disclose adequate structure, material, or acts that perform the function recited in the elements recited in claims 33 and 27. We reverse, *pro forma*, the Examiner’s prior art rejections of claims 27-34. We further conclude that claims 27-34 are unpatentable under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 112, first paragraph.

VIII. DECISION

In view of the foregoing discussion, we reverse, *pro forma*, the Examiner’s rejections of claims 27-34. We enter a new ground rejection of

claims 27-34 under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 112, first paragraph.

37 C.F.R. § 41.50(b) provides that "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides that, within two months from the date of the decision, the appellant must exercise one of the following options to avoid termination of proceedings of the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

rwk

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